



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0446-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Serge RESTLÉ et al.)	Group Art Unit: 1617
)	
Application No.: 09/360,521)	Examiner: L. Williams
)	
Filed: July 23, 1999)	Confirmation No.: 4299
)	
For: AMINATED SILICONE)	
DETERGENT COSMETIC)	
COMPOSITION AND USE)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated January 29, 2007. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

03/30/2007 HMARZI1 00000015 09360521

01 FC:1403

1000.00 OP

I. Argument

In the Answer, the Examiner has maintained the rejections of record. Appellants believe that the Examiner's positions have already been addressed in large part in the Appeal Brief, and thus maintain that a *prima facie* case of obviousness has not been established for the reasons set forth in the Appeal Brief filed October 27, 2006. A few of the Examiner's positions do warrant additional comment and Appellants submit a *prima facie* case of obviousness has also not been established for the additional reasons discussed below.

A. Claims 1-9, 13-32, 34-41, and 43-47

1. Identifying Various Claim Limitations in the Prior Art Does Not Alone Provide Evidence of Obviousness

The Examiner continues to improperly maintain that the combination of Decoster '211 and Decoster '747 renders the claimed invention obvious because each disclose some of the presently claimed limitations. While this may be true, mere knowledge in the art of a claim element is not a substitute for a motivation or suggestion to make the claimed invention. But the Examiner's continued rejection appears to be guided by this fallacy.

At its essence, the Examiner's position appears to be that one skilled in the art would modify Decoster '747 to arrive at the claimed invention simply because Decoster '211 discloses that an aminosilicone with an amine index value of .5 meq/g was known in the art. The Examiner takes this position even though Decoster '211 discloses a structurally different aminated silicone. Attempting to gloss over this fact, the Examiner concludes the mere recognition of "an aminated silicone as useful in a detergent cosmetic composition for the hair is sufficient suggestion to render the instant claims

obvious over '747." *Examiner's Answer*, page 10. This conclusion, however, does not mesh with the disclosures of the two cited references or the law.

While it is true that the disclosures of the cited references generally teach the use of aminated silicones in hair compositions, the Examiner continues to ignore the specific teachings of these references that do not suggest making the claimed invention. Indeed, in an attempt to improperly tie the disclosure of Decoster '211 to the disclosure of Decoster '747, the Examiner states that the aminated silicone taught by Decoster '211 is equivalent and comparative to the one taught by Decoster '747. *Examiner's Answer*, page 8. This is incorrect and an improper summary of these two references respective disclosures. As discussed in great detail in Appellants' Appeal Brief dated October 27, 2006 (at pages 20-22), Decoster '211 reference compares the amodimethicone of Decoster '747 to its inventive aminated silicone. It turned out that the silicone disclosed in Decoster '747 performed much worse than the Decoster '211 inventive silicone. Decoster '211, col. 13, lines 9-55. Thus, contrary to the Examiner's assertion, Decoster '211 does not disclose that the aminated silicone of Decoster '747 is equivalent. In fact, it discloses just the opposite - the Decoster '747 aminated silicone is inferior.

Second, as a matter of law, the Examiner has improperly premised the rejection on the supposed knowledge of one skilled in the art. For example, he posits that one of ordinary skill in the art "would have recognized an aminated silicone of '747, possessing an amine index as claimed, would be useful [in hair compositions.]" *Examiner's Answer*, pages 10, 11. The knowledge of one skilled in the art, however, cannot be used solely to justify the rejection. Indeed, the Federal Circuit has cautioned that the

fact “[t]hat knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge.” *Smiths Industries, Medical Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999). Thus, simply because the individually claimed components are known in the art, there must be some evidence other than the supposed knowledge of one skill in the art to link these components to one another to make the claimed invention. There, however, is no such evidence here. Accordingly, the Examiner rejection is improper and should be reversed and withdrawn.

2. The Examiner Misunderstands the Legal Concept of “Teach Away”

In the Answer, the Examiner argues that Appellants’ teaching-away argument fails because if Appellants assert the same amino-containing silicone compositions that are presently claimed cannot have a meq/g value of greater than 0.5, then the claimed amino containing silicone compositions cannot have that amine index value either. *Examiner’s Answer*, page 12. This argument misses the point.

A prior art reference that teaches away from the claimed invention cannot render that invention obvious. *Tec Air, Inc. v. Denso Mfg. Michigan, Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d 1295, 1298 (Fed. Cir. 1999). That is and always has been the law. It is the Appellants position that Decoster ‘747 teaches away from the use of an amine number greater than or equal to 0.4 meq/g in its inventive composition by disclosing that aminosilicones with amine numbers less than 0.1 meq/g are advantageous. *Appeal Brief*, page 20. Accordingly, one skilled in the art would not have been motivated, upon reading Decoster ‘747, to make the claimed invention.

Contrary to the Examiner's position, teaching away has nothing to do with whether the claimed invention could or could not have an amine index value of greater than or equal to 0.4 meq/g. An obviousness analysis focuses on the prior art not the claimed invention. More specifically, the obviousness analysis focuses on what the prior art would have suggested to one of ordinary skill in the art. In this case, the prior art suggested that aminosilicones with amine numbers less than 0.1 meq/g are advantageous and, conversely, that aminosilicones with amine numbers greater than or equal to 0.4 meq/g are not advantageous. This teaching necessarily leads away from the use of amine numbers greater than 0.1 meq/g. Accordingly, for at least this additional reason, the rejection should be reversed and withdrawn.

3. The Examiner has Not Responded to Appellants Arguments of Record Concerning the "Transparency Limitation"

The Examiner continues to ignore Appellants arguments of record regarding the transparency limitation. In his Answer, he simply reiterates the argument that "a products and its properties are inseparable." *Examiner's Answer*, page, 11. Appellants, therefore, maintain their arguments of record and add this additional comment.

The claims of the present invention specifically recite that the composition must be transparent. Thus, the Examiner must consider this limitation and determine whether the prior art would have suggested this limitation along with the other inventive components. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). Because the Examiner failed to make that assessment and instead relied on inapplicable case law, the rejection is improper and should be reversed and withdrawn.

B. Claims 10-12

The Office has maintained the rejection of claims 10-12 as unpatentable over Decoster '747 in view of Decoster '211. Because the Examiner did not set forth any new arguments, Appellants respectfully disagree for reasons set forth in the Appeal Brief filed on October 27, 2006, at page 24, and ask that this rejection be reversed and withdrawn.

C. Claims 33 and 42

The Office has maintained the rejection of claims 33 and 42 as unpatentable over Decoster '747 in view of Decoster '211 and further in view of Naito. Because the Examiner has set forth no new arguments, Appellants respectfully disagree for reasons set forth in the Appeal Brief filed on October 27, 2006, at page 24, and ask that this rejection be reversed and withdrawn.

II. Conclusion

For the reasons given above, pending claims 1-47 are allowable and reversal of the Examiner's rejection is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 29, 2007

By: Mareesa A. Frederick
Mareesa A. Frederick
Reg. No. 55,190